

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
)
Nishizumi NISHIMUTA et al.) Group Art Unit: 1614
)
Application No.: 10/046,575) Examiner: Vickie Y. Kim
)
Filed: January 16, 2002) Confirmation No.: 4939
)
For: EXTERNAL PREPARATION FOR)
SKIN DISEASES CONTAINING)
NITROIMIDAZOLE)
)

REPLY TO ELECTION OF SPECIES REQUIREMENT TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed is a Reply to Election of Species Requirement for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____.
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$375.00 (2801) ☐ \$750.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted ___, on ___, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least ___, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.
- ☒ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					-0-

☐ A claim fee in the amount of \$_____ is enclosed.

☐ Charge \$_____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R.
§§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment,
to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____

Susan M. Dadio
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Date: April 24, 2003



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Patent

Attorney's Docket No. 018995-452

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SKIN DISEASES CONTAINING)	
NITROIMIDAZOLE)	

REPLY TO ELECTION OF SPECIES REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Official Communication mailed on March 25, 2003, requiring election of species pursuant to 35 U.S.C. § 121, Applicants offer the following reply.

First, the Examiner has required Applicants to elect a single disclosed species with regard to a specific exemplified compound. Accordingly, Applicants hereby elect, without traverse, tinidazole as the specific exemplified compound. Tinidazole, *i.e.*, 1-(2-ethylsulfonyl-ethyl)-2-methyl-5-nitroimidazole (Compound No: 163), is represented by general formula I wherein R¹ is a methyl group, R² is CH₂CH₂SO₂Et, R³ is a hydrogen atom, and R⁴ is NO₂.

Second, the Examiner has required Applicants to elect a single disclosed species with regard to a particularly claimed skin condition. Thus, Applicants hereby elect, without traverse, atopic dermatitis as the particular skin condition.

Third, the Examiner has required Applicants to elect a single disclosed species with regard to a single enhanced combination of drugs. Hence, Applicants elect, without traverse, a steroid as the medicine in claim 13 which is applied simultaneously or separately with the nitroimidazole derivative

The Examiner stated in the Official Action that "[w]ith the election of a specific exemplified compound, a generic concept will be identified by the examiner as the inventive group for examination." It is unclear whether, by this statement, the Examiner has waived the requirement that Applicants provide a listing of all claims readable on the elected species. However, to the extent the M.P.E.P. indicates that such a listing should be included for the reply to be complete, Applicants hereby provide a list of claims readable upon each of the respective species:

(1) at least claims **1, 2, 3, 6, 9, 10, 11, 12**, and 13-31 read on the elected tinidazole compound;

(2) at least claims 1-15, **16**, and 31 read on atopic dermatitis as the particular skin condition; and

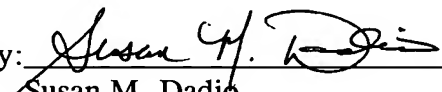
(3) at least claims 1-12, **13**, and 15-31 read on a steroid as the medicine which is applied simultaneously or separately with the nitroimidazole derivative.¹

¹ The claims in bold are those claims which are readable upon all the elected
(continued...)

In the event that there are any questions relating to this Reply to Election of Species Requirement or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of the application may be expedited.

Respectfully submitted,

Burns, Doane, Swecker & Mathis, L.L.P.

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Date: April 24, 2003

¹(...continued)

species as a whole. In other words, those claims which read upon the claimed method whereby tinidazole was used in accordance with the claimed method to treat or ameliorate atopic dermatitis, and a steroid could also be applied simultaneously or separately with tinidazole pursuant to the claimed invention.